

REMARKS

Status of Claims

Claims 1 and 5-12 are pending, of which claims 1 and 11-12 are independent. Claims 1 and 11-12 have been amended to correct informalities in the claim language and to more clearly define the intended subject matter. Care has been taken to avoid introducing new matter.

Rejection under 35 U.S.C. § 112

Claims 1 and 11-12 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner asserts that the limitation “does not include a monomer capable of being radical-polymerized” does not appear to have support. This rejection is traversed for at least the following reasons.

Applicant respectfully submits that an objective standard for determining compliance with the written description requirement is whether the description clearly allows persons of ordinary skill in the art to recognize that he or she invented what is claimed. *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). The subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement (see, M.P.E.P. 2163.02). Under these well-established legal standards, Applicant respectfully submits that claims 1 and 11-12 satisfy the written description requirement under 35 U.S.C. § 112, first paragraph.

In the present disclosure, the negative electrode has a film including an organic peroxide formed on its surface (see, paragraph [0036] of the specification). In such a case, one of skill in the art would understand and recognize that the non-aqueous electrolyte (as well as the positive electrode or the negative electrode) is free from a monomer capable of being radical-polymerized.

As such, Applicant respectfully submits that claims 1 and 11-12, as amended, satisfy the written description requirement under 35 U.S.C. § 112, first paragraph.

Rejections under 35 U.S.C. § 103

Claims 1 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshinori et al. (JP 2004-047317) in view of Negoro (US 6,232,021). Claims 5 and 7-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshinori et al. in view of Negoro and further in view of Kezuka et al. (US 2002/0031710). These rejections are traversed for at least the following reasons.

Applicant respectfully submits that it would not have been obvious to combine Yoshinori with Negoro because there is no motivation or suggestion to do so and such a combination would impair the purpose the Yoshinori. In rejecting claims 1 and 11-12, the Examiner conceded that Yoshinori fails to disclose the use of the claimed lithium-containing composite oxide, and relied on Negoro asserting that Negoro discloses the use of LiCoO_2 or LiNiO_2 . The Examiner concluded that it would have been obvious to replace LiMn_2O_4 of Yoshinori with LiCoO_2 or LiNiO_2 of Negoro. Applicant respectfully disagrees.

Applicant respectfully submits that Yoshinori discloses that manganese oxide is preferable for a secondary battery from a viewpoint of resources and cost (see, paragraph [0003]), and that the manganese oxide has a problem that manganese would dissolve into organic electrolysis liquid, thereby reducing the life of a battery (see, paragraph [0004]). Thus, the purpose of Yoshinori is to solve the above problem caused in a battery utilizing manganese oxide, by suppressing deposition of manganese on the active material (see, paragraph [0017]). As such, one of skill in the art who is looking into the teaching of Yoshinori would not have been

motivated to replace LiMn_2O_4 with oxide without including manganese because such a modification would impair the purpose of Yoshinori (suppressing deposition of manganese) (see, M.P.E.P. 2143.01).

As such, it is clear that it would not have been obvious to combine Yoshinori with Negoro to arrive at the subject matter of claim 1. The remaining cited reference does not cure the deficiencies of Yoshinori and Negoro. Accordingly, claim 1 and all claims dependent thereon are patentable over the cited references. Thus, it is requested that the Examiner withdraw the rejections of claims 1 and 5-12 under 35 U.S.C. §103.

Conclusion

Having fully responded to all matters raised in the Office Action, Applicant submits that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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